

### Office Action Summary

**Application No.**

09/154,965

**Applicant(s)**

REDING ET AL.

**Examiner**

William J. Deane

**Art Unit**

2614

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10, 16-25 and 33-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10, 16-18 and 33-35 is/are allowed.
- 6) ☒ Claim(s) 19-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Allowable Subject Matter***

Claims 1 – 10, 16 – 18 and 33 - 35 allowed.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19 - 20 and 22 - 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morganstein in view of Lennig et al.

Morganstein teaches the claimed device as discussed above except that the receiving of a telephone number from the operator. Note that Lennig does such (Col. 7, lines 13 - 15). It would have been obvious to one of ordinary skill in the art to have the second look-up return a telephone listing as taught by Lennig et al in the steps of Morganstein as such would only entail the programming of the call processing unit of Morganstein to request a listing rather than an insurance policy number.

With respect to claim 22, neither reference discloses the type of database look-up that is performed. However, it would have been obvious to one of ordinary skill in the art to have used any look-up method that was deemed necessary.

With respect to claim 23, note that both Morganstein and Lennig et al teach database look-ups for businesses like insurance Co. as discussed above and Lennig

specifically teaches look-ups for businesses (Col. 7, line 19). Since a restaurant is a business, it would have been obvious to one of ordinary skill in the art to list restaurants in the business listings and as stated above - this would only entail an obvious programming change to the call processing unit of Morganstein.

With respect to claims 24 - 25, such is obvious after the discussion above. The use of text to speech in providing user prompts from text databases is well known and it

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morganstein in view of U.S. Patent No. 4,907,247 (Nomura et al.).

Morganstein teaches the claimed device as discussed above, except for the ability to fax directions to a caller. However, note that Nomura et al teach such a limitation as claimed by applicant (see Abstract, Col. 24, lines 29 - Col. 25, line 7 and claim 5). It would have been obvious to one of ordinary skill in the art to have incorporated such a method as taught by Nomura et al into the Morganstein method as such would only entail the substitution or addition of well known databases.

### ***Response to Arguments***

Applicant's arguments filed 07/02/2008 have been fully considered but they are not persuasive.

Specifically, notwithstanding applicants' argument, claims 19 – 25 are not of a similar scope as the other allowed claims. Compare claim 1 and claim 33 with claim 19. Since applicant is entitled to only one invention per application, Applicants are being given an opportunity to amend claim 19 to be more in line with claims 1 and 33. If

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applicants fail or wish not to amend claim 19, a restriction will result in the next office action.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bill Deane whose telephone number is (571) 272-7484. In addition, facsimile transmissions should be directed to Bill Deane at facsimile number (571) 273-8300.

29Sep2008

/William J Deane/

Primary Examiner, Art Unit 2614